

## **REMARKS**

### **A. Front Page of Office Action**

The cover page of the July 29, 2002 office action indicates that claims 32-70 are pending and that claims 32-70 are rejected.

The applicants agree that claims 32-70 are pending, and that the front page summary of the office action reflects the contents of the office action.

The applicants point out that the PTO-1449 paper number 4 attached to the office action does not contain the examiner's signature and date, only the examiner's initials which are next to each document listed in the PTO-1449. A copy of PTO-1449 with the examiner's initials and dated signature is respectfully requested.

### **B. Summary and Response to Items Enumerated in the Office Action**

#### **1. Item 1**

In item 1, the examiner quotes the first paragraph of 35 U.S.C. 112.

In reply, applicants note this.

#### **2. Item 2**

In item 2, the examiner rejects claims 32-70 under 35 USC 112, first paragraph. The examiner states that:

Claims 32-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are not enabled by the specification, because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data. Since the specification does not discuss these critical independently claimed elements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claimed features are not enabled by the specification because examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention such that those in the art could make or use the invention. The specification merely recites the same language used in the claims and does not teach elements that one skilled in the

art would need to make or use the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed non-enabling feature, those claims are also rejected as being non-enabling from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter. [Office action page 2 line 11 through page 3 line 8.]

In reply, the applicants point out that there is almost *ipsus verbis* support for the subject claim recitations in the specification, and that the claimed limitations are supported. Therefore, the rejections for lack of a written description are improper.

With respect to the examiner's assertion that "the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network," the applicants respectfully submits that page 9 lines 4-9 of the specification clearly discloses a consumer selecting coupon offers out of a plurality of offers after log-in and switching to offer browser. Page 9 lines 4-9 of the specification read as follow:

Basically, the offer browser 22 receives offer data from the manufacturers 14 on a periodic basis, and displays the offers to consumers 10 who have logged in to the system. The offer and sub-offer structure permits consumers to select coupon offers, rebate offers, or information offers made available by the manufacturers. Selected offers are accumulated in a session record maintained for the time that each consumer is logged in to the system. [Page 9 lines 4-9.]

With respect to the examiner's assertion that the specification does not support "generating token data depending on selection data," the applicants respectfully submits that page 24 lines 2-6 of the specification clearly discloses that a server transmits token images defining coupon offerings to the user and the specification page 24 lines 2-6 discloses depending coupons on selection data. Page 24 lines 2-6 of the specification read as follow:

Generating a "token" instead of coupon, as described above with reference to FIG. 13, also reduces the risk of fraud. Another technique similar to this is depicted in FIG. 18. A token 316 is generated by the user's computer 302 after interaction with the distribution server 300. The user chooses from incentive offers as described above, but instead of a coupon the computer 302 generates the token 316. [Page 24 lines 2-6.]

With respect to the examiner's assertion that "[the] specification merely recites the same language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention," the applicants respectfully submits that this assertion is incorrect. In the specification of the present application, various examples are given in many paragraphs to

support the limitations discussed above. Some of these paragraphs read as follows:

The shopping list maker is entered, as indicated in block 220, from the main menu, or from any of various other screens. *The user may select a store department (block 222), such as meat, produce, and so forth, then select from displayed items sold in that department, as indicated in block 224.* The selected items are added to the session record, as indicated in block 226, before a return is made to the main menu, as indicated in block 228. Items may be selected for adding to the shopping list whether or not any of the items is subject to a manufacturers' or supermarket special offer. Optionally, manufacturer and retailer offers may be displayed in the appropriate sections to alert the user of specials available. [Page 14 lines 13-21; emphasis supplied.]

FIG. 10 shows the principal functions performed when the user enters the final list generation phase, as indicated in block 250. The system builds the final list, as indicated in block 252, *using the session record that has accumulated items selected by the user*, as indicated in block 254. The final list is displayed to the user, as indicated in block 256, and the user may then exit to the main menu (block 258) or go to an exit page (block 260), which may have links to other shopper savings opportunities. The final list generation phase also contains hyperlinks to sites established by individual manufacturers and retailers. Finally, the system displays a "thank you" message and ends the session, as indicated in block 262. [Page 15 lines 13-21; emphasis supplied.]

The applicants respectfully submit that all claimed limitations are disclosed in the specification. Moreover, the examiner's assertion that the claim limitations are not enabled is without factual basis. It is well known as of the date of invention how to program web sites to provide the claimed functionality. Thus, withdrawal of the rejection is respectfully requested.

**3. Item 3**

In item 3, the examiner quotes the second paragraph of 35 USC 112.

In reply, the applicants note this.

**4. Item 4**

In item 4, the examiner rejects claims 1-20 under 35 USC 112, second paragraph. The examiner states that:

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the specification does not provide an antecedent basis of transmitting selected data or

generating token data. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specifications such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter. [Office action page 3 line 12 through page 4 line 8.]

In reply, the applicants note that claims 1-20 have been canceled. Thus, the applicants assume that the examiner meant to reject claims 32-70, and the applicants respond accordingly.

First, the applicants point out that there is almost *ipsus verbis* antecedent basis support for the subject claim recitations in the specification. See page 9 lines 10-21, page 14 lines 13-21, page 15 lines 13-21, and page 19 lines 8-12. Thus, the claimed recitations are supported.

Second, the second paragraph of 35 USC 112 is directed to the claims, not to the specification. Therefore, the examiner's assertion that "the specification does not provide an antecedent basis of transmitting selected data or generating token data" is not a basis to reject the claims under the second paragraph of 35 USC 112. Therefore, there is no factual assertion supporting the indefiniteness rejections. In summary, since the rejected claims are canceled and there is no basis for the rejections, the rejections are improper and should be withdrawn.

**5. Item 5**

In item 5, the examiner quotes 35 USC 102(a), (b), and (e).

In reply, the applicants note this.

**6. Item 6**

In item 6, the examiner rejects claims 32-70 under 35 USC 102(a) and 35 USC 102(b).

The examiner states that:

Claims 32-70 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Scroggie et al., (WO 97/23838), or Beach et al. (WO 97/30409) and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US 5,430,644), or Day et al. (US 5,857,175) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kepecs (US 6,330,543).

[Office action page 5 lines 1-7.]

In reply, the applicants respectfully traverse these rejections because they are legally improper and not supported by substantial evidence.

The Scroggie et al. (WO 97/23838), Beach et al. (WO 97/30409), and Kepecs (US 6,330,543) references are not prima facie prior art. The same priority dates are claimed in this application and Scroggie et al. (WO 97/23838). Therefore, it is not prior art. Moreover, Beach et al. and Kepecs are antedated by the priority date for claims in this application.

Furthermore, Day et al. (US 5,857,175), Von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863) and Deaton et al. (US 5,430,644) do not anticipate or suggest the subject matter defined by claims 32-70.

Day discloses a system for providing discounts at the check-outs in a particular store. In contrast, claim 32 defines a system that “transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network,” and then “generating token data depending on said selection data.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, Day does not disclose and claim 32 defines a system that “[transmits] selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network,” and later “transmitting said token data from said main computer to said personal computer over said computer network.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, Day does not disclose and claim 32 defines a system that “[transmits] said token data from said main computer to said personal computer over said computer network; identifying said token data in a retail store in association with items being purchased at said retail store; generating a purchase incentive based on said discount items.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Von Kohorn discloses a system that transmits and displays product information in a viewer’s home. In the system disclosed by Von Kohorn, tokens and coupons are generated in a

home generating unit after the viewer entering selected product information.

Von Kohorn does not disclose an on line distribution of purchase incentives. In contrast, claim 32 defines a system “transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network.” Further, Von Kohorn does not disclose either a two-way system interactive with the end users or a system interacting with the retailers. To the contrary, claim 32 defines a system “identifying said token data in a retail store in association with items being purchased at said retail store; determining discount items being purchased corresponding to said at least one product discount from said identified token data; and generating a purchase incentive based on said discount items.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Deaton discloses automatic check reading techniques that enable the detection of a customer’s checking account number on a check.

Deaton does not disclose on line distribution of coupons or similar incentives. In contrast, claim 32 defines a system that “[transmits] said token data from said main computer to said personal computer over said computer network.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Ferguson discloses a system for automating data acquisition and processing at a check stand point-of-sale in a retail outlet. The abstract of Ferguson reads as follows:

Preferred embodiments include a first local area network of POS terminals for initiating merchandise purchase transactions. All of the purchase transactions in the first local area network are passively monitored to acquire primary purchase data. A second local area network of lane terminal devices inputs secondary data, including discount coupon information, check information and bank card information to a universal system controller. The universal system controller mirrors the primary information, processes the primary and the secondary information, and generates output information to the POS terminals of the first local area network via the lane terminal devices of the second local area network, the output information including coupon verification data, coupon amount data, check verification data and bank card verification data.

Ferguson does not disclose generating token data depending on selection data selected from a personal computer. In contrast, claim 32 defines a system that “[transmits] said token data from said main computer to said personal computer over said computer network” and then

“generat[es] token data depending on said selection data.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

**7. Item 7**

In item 7, the examiner quotes 35 USC 103(a).

In reply, the applicants note this.

**8. Item 8**

In Item 8, the examiner summarizes the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 USC 103(a).

In reply, the applicants note this.

**9. Item 9**

In item 9, the examiner rejects claims 1-20 under 35 USC 103(a). The examiner states that:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner’s personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selections data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally

equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claim invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention. [Office action page 5 line 24 through page 8 line 13.]

In reply, the applicants note that claims 1-20 have been canceled. Thus, the rejection is improper and should be withdrawn. The applicants assume that the examiner meant to reject claims 32-70, and the applicants respond accordingly.

The examiner alleges a prior art date for the PerformanceBike.com's web site of "[s]ince at least 1994" based on "examiner's personal knowledge."

In reply, the applicants first point out that the PerformanceBike.com website printout enclosed with the July 29, 2002 office action clearly indicates a copyright year of 2000, which is the prima facie date associated with that website.

Second, the applicants point out that the PerformanceBike.com web site does not distribute incentives for in-store use, contrary to the examiner's assertion.

Third, applicant points out that website did not exist in 1994, contrary to the examiner's assertion. I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension at



that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

The examiner did not provide a declaration of his personal knowledge of the PerformanceBike web site, pursuant to MPEP 2144.03 and 37 CFR 1.104(d)(2). Therefore, the examiner's non-declaration factual assertions are not probative. The facts I noted above, and Mr. Ruggeri's assertions, as conveyed to me, are sufficient to overcome any probative value of the examiner's allegations. However, if the examiner does provide a declaration and maintains these rejections, I will request that Mr. Ruggeri provide a corresponding declaration.

**10. Item 10**

In item 10, the examiner summarizes the judicially created doctrine of non-statutory double patenting grounded in public policy. The examiner states that:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.373(b). [Office action page 8 line13 through page 9 line 6.]

In reply, the applicants note this.

**11. Item 11**

In item 11, the examiner rejects claims 32-70 under the judicially created doctrine of obviousness-type double patenting. The examiner states that:

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim of encoded [sic] ('469 patent) is an obvious variation of the application claimed token [sic] and the patented claimed [sic] advisory message ('541 patent) is an obvious variation of the application claimed general purchase incentive because both perform the same function in the same manner with the same result. [Office action page 9 line 9-15.]

In reply, the applicants traverse the rejections based upon US 5,970,469's claims, since those claims define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives.

The applicants also traverse the rejections based upon claims of the US 6,185,541 patent, since those claims define details of printing coupons by a user's computer, region data analysis, and transmission of terms of an incentive to an in-store server, whereas the claims in this application define identifying token data in a retail store for generating a purchase incentive.

## **12. Item 12**

In Item 12, the examiner rejects claims 32-70 under 35 USC 103(a). The examiner states that:

Claims 32-70 are rejected under 35 U.S.C. 103(a) as being obvious over copending Application Nos. 09/478,351 or 09/567,274 or 09/716,404. Each application contains claims reciting obvious variation of the claimed method, system, and program of:

- transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

- displaying said plurality of product discounts at said personal computer based on said promotion data;

- transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

- generating token data depending on said selection data;

- transmitting said token data from said main computer to said personal computer over said computer network;

- identifying said token data in a result store in association with items being purchased at said retail store;

- determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

- generating a purchase incentive based on said discount items along with instant or

internet/intranet token scanning identification.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2). [Office action page 9 line 16 through page 11 line 13.]

In reply, the applicants traverse these rejections because the applications relied upon do not qualify as prior art (1) because 09/478,351 published 8/29/02 as filed 5/9/02, (2) 09/567,274 appears from the PTO website to be unpublished, and (3) 09/716,404 appears from the PTO website to be unpublished.

**13. Item 13**

In item 13, the examiner indicates prior art made of record and not relied upon is considered pertinent to applicants' disclosure, citing "High-Tech Calling at Home" by Floyd Egner teaches general purchase incentive.

In reply, the applicants note this.

**14. Item 14**

In item 14, the examiner indicates contact information.

In reply, the applicants note this.

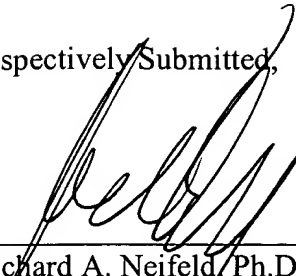
Respectively Submitted,



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Date

12/23/02

  
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Printed: October 23, 2002

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